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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,815	09/25/2003	Paul Moulton	A35985 - 070121.0573	7621
21093 7590 07/24/2009 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498				
EXAMINER				
NGUYEN, CHI Q				
ART UNIT		PAPER NUMBER		
3635				
NOTIFICATION DATE		DELIVERY MODE		
07/24/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

10/670,815

Applicant(s)

MOULTON ET AL.

Examiner

CHI Q. NGUYEN

Art Unit

3635

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 10, 13-15, 17-23, 26-30, 32 and 42-51 is/are pending in the application.
- 4a) Of the above claim(s) 2-8, 26, 27, 30, 32, 42, 43, 50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 17-23, 28, 29, 45-47 and 49 is/are rejected.
- 7) ☒ Claim(s) 44 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of species II (two lateral wings) in the reply filed on 4/20/2009 is acknowledged. The traversal is on the ground(s) that recitation of "at least one" of claim 32 inherently includes embodiments having one wing and embodiments having two wings. This is not found persuasive because as set forth in the previous response that the at least one lateral wing does not equivalent to a first and a second lateral wings. For example, a prior art shows only one lateral wing does not satisfy a claim that required a first and a second lateral wings, etc.

The requirement is still deemed proper and is therefore made FINAL.

Status of Claims

Withdrawn claims: 2-8, 10, 26-27, 30, 32, 42-43 and 50-51.

Cancelled claims: 1, 9, 11-12, 16, 24-25, 31 and 33-41.

Pending claims: 13-15, 17-23, 28-29 and 44-49.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lateral wing is solid structure must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, the citation "where a surface of each lateral wing is bonded to a surface of an adjacent concrete slab", the concrete slab is not positively cited in the independent claim 45.

Claim 18 is objected to because of the following informalities: the applicant is advised to spell out EPDM once in the claim(s). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim, the phrase "at least about" renders the claim indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13, 15, 18-23, 28-29, 46-47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,584,152 to Baerveldt.

Claim 45:

Baerveldt discloses a one-piece compression seal (Fig. 3) for an expansion joint, comprising: a compressible sealing portion having an elastic accordion-like membrane structure 11 formed by a plurality of channels and a horizontal width; and first and second lateral wings 12 each extending from an upper portion of the compressible sealing portion, the first and second lateral wings 12 each having a wall thickness (at 13) greater than the wall thickness of the compressible sealing portion, and further wherein the first and second lateral wings 12 have concrete-contacting lower surfaces configured to grip adjacent concrete slabs.

Claim 46:

Wherein each of the first and second lateral wings 12 has a vertical height and the compressible sealing portion has a vertical height, the vertical height of the compressible sealing portion being greater than the vertical height of the first and second lateral wings (see Fig. 3).

Claim 47:

Wherein at least one lateral wing 12 has a solid structure.

Claim 49:

Wherein at least one lateral wing 12 has at least one surface having a pattern of grooves 3 (see Fig. 4).

Claim 15:

Wherein a surface of each lateral wing 12 is bonded to a surface of an adjacent concrete slab by bolts B.

Claim 18:

Wherein the one-piece compression seal comprises extruded EPDM rubber or extruded ethylene propylene terpolymers (col. 1, lines 50-55).

Claim 19:

Wherein the compressible sealing portion comprises longitudinal tubes (Fig. 3).

Claim 20:

Wherein the compressible sealing portion comprises a membrane structure having at least one channel, wherein the channel allows the compressible sealing portion to vary in lateral width (Fig. 3).

Claim 21:

Wherein at least one lateral wing comprises longitudinal channels 3.

Claim 22:

Wherein at least one lateral wing is hinged from the compressible sealing portion (Fig. 3).

Claim 23:

Wherein cross sections of the compression seal along its length have substantially the same structural configuration (Fig. 3).

Claim 28:

Wherein the channel deforms to allow the compressible sealing portion to vary in lateral width (Fig. 3).

Claim 29:

Wherein the channel allows the compressible sealing portion to vary in lateral width by deforming vertically with variations in the lateral width of the compressible sealing portion (Fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,584,152 to Baerveldt.

Claims 14:

Baerveldt discloses the claimed invention as stated and further discloses the lateral wing 12 is secured to concrete slab by bolts B (see Fig. 3) but does not disclose expressly wherein a surface of each lateral wing is bonded to a surface of an adjacent concrete slab by adhesives. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to use an adhesive instead of bolts in order to prevent cracking leaks that may caused by bolts. Furthermore, applicant has not disclosed the criticality of this feature.

Claims 13 and 17:

Baerveldt discloses the claimed invention as stated but does not disclose expressly wherein the wall thickness of each lateral wing is at least about one half on an inch and the one-piece compression seal comprises an elastic material. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have different size of thickness wall and type of materials for its desirable applications. Furthermore, applicant has not disclosed the criticality of this feature.

Allowable Subject Matter

Claims 44 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 45, 14-15, 17-23, 28-29, 46-47 and 49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

/C. Q. N./
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635